

REMARKS

The above-identified application has been carefully reconsidered in view of the Office Action mailed April 26, 2004. Early and favorable reconsideration and allowance of the application as now presented are respectfully requested.

The specification has been amended to correct various typographical and other errors. The Examiner's helpful suggestions as set forth in the Office Action regarding errors in the specification are noted with appreciation.

The requirement for a new title is respectfully traversed. The title of the application has been reconsidered in view of the Examiner's statements as set forth in the Office Action. Applicant believes that the original title of the application is entirely descriptive of the present invention. Should the Examiner have any suggestions as to a new or revised title for the application, the undersigned attorney for applicant will be most pleased to entertain them.

The double patenting rejection as set forth in the Office Action is respectfully traversed. Application Serial No. 10/093,242, the parent of the present application, included claims 33-64. The claims of the prior application were subjected to a Requirement for Restriction wherein the Examiner grouped claims 33-62 in Group I and claims 63 and 64 in Group II. Applicant elected the claims of Group I, i.e., claims 33-62, for prosecution in the parent application. The present application is a divisional application comprising claims 63 and 64 from the parent application.

Applicant relies on § 121 of the Patent Act, i.e., 35 U.S.C. § 121. § 121 prevents a parent application from being used as a reference against claims presented in a subsequently filed divisional application.

Presented herewith are copies of page 12-77 through 12-79 from Chisulm on Patents. Referring thereto, the present divisional application was filed in response to a Restriction Requirement actually imposed and not withdrawn by the Examiner. Second, claims 63 and 64 as filed were not been changed at all from the claims at the time the requirement was made.

Therefore, pursuant to 35 U.S.C. § 121 and the case law cited in the pages from Chisulm on Patents presented herewith, the double patenting rejection as set forth in the Office Action will not lie. Withdrawal of the double patenting rejection is therefore respectfully requested.

The rejection of claims 63 and 64 as unpatentable over the disclosure of Euverard et al. patent number 4,522,292 granted June 11, 1985 is also respectfully traversed. Having reference to Figure 1 of the '292 patent, products are received in the device disclosed therein on an infeed apparatus 21 comprising a conveyor belt 25. The infeed conveyor 21 serves as a grouping conveyor in that products are received thereon in groups under the control of a gate 27. Having been grouped on the infeed conveyor 21, products are conveyed thereby onto the platform 65 of the turntable 60 under the action of the infeed conveyor 21.

Claim 63 includes the steps of "providing a grouping apparatus for receiving individually wrapped bakery products" and "arranging groups of between about one and about six wrapped bakery products on the grouping apparatus". Referring to Figure 1 of the drawings of the present application, the grouping apparatus referred to claim 63 could comprise the grouping apparatus 108, however, it will be understood that other types and kinds of grouping devices could also be utilized in the practice of the invention.

Referring again to claim 63, the claim also includes the steps of “providing a turntable” and “providing a transfer apparatus for moving groups of wrapped bakery products from the grouping apparatus onto the turntable”.

Having reference once again to the '292 patent which is cited in the Office Action, the device disclosed therein could be considered as including a grouping apparatus. This would necessarily be an infeed conveyor 21. However, in the operation of the device disclosed in the '292 patent, bakery products are transferred directly from the groping apparatus (infeed conveyor 21) onto the turntable 60. In direct contradistinction to the teaching of the '292 patent, claim 63 calls for a transfer apparatus for moving groups of wrapped bakery products from the grouping apparatus onto the turntable. No such device is disclosed or fairly suggested by the '292 patent.

The use of the transfer apparatus of the present invention comprises an important improvement over the disclosure of the '292 patent. Thus, by means of the transfer apparatus it is possible to accumulate a subsequent group of wrapped bakery products on a grouping apparatus while the previous grouping of wrapped bakery products is being transferred onto the turntable. No such procedure is possible in the operation of the device disclosed in the '292 patent given the fact that the same device is used for grouping of bakery products and for transfer thereof onto the turntable.

Reconsideration and favorable action regarding claim 63 of the present application are therefore respectfully requested.

Referring to drawing figures 12-63 of the present application, the apparatus disclosed in the present application transfers groups of wrapped bakery products directly from the surface of the

turntable 112 into a bakery tray T. There is no intervening mechanism whatsoever save and except the slip sheet 180 which is merely a flexible extension on the surface of the turntable.

In direct contradistinction to the apparatus of the present invention, the '292 patent includes both a staging deck 70 and a container loader 80 to accomplish the function of transferring wrapped bakery products from the turntable 60 to a bakery tray. As will therefore be obvious, the '292 patent does not teach or fairly suggest transferring bakery products directly from the turntable into a bakery tray as is positively recited in claim 64 as now presented.

Consistent with the foregoing, claim 64 has been amended positively to recite the step of moving patterns of wrapped bakery products directly from the turntable into bakery trays under the action of the transfer apparatus. It is respectfully submitted that no such step is taught or fairly suggested by the disclosure of the '292 patent.

It is therefore respectfully submitted that the present application is in condition for favorable action and allowance. Should anything further be required in order to place the application in condition for allowance, the courtesy of a telephone interview is requested. The Examiner may contact the undersigned attorney for applicant at 214-739-0088.

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Respectfully submitted,

MICHAEL A. O'NEIL, P.C.

A handwritten signature in cursive script that reads "Michael A. O'Neil". The signature is written in dark ink and is positioned above a horizontal line.

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RESTRICTIONS

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§ 12.05 Double Patenting

Generally, the doctrine of double patenting precludes a second patent for the same invention.¹ Prior to 1952, both the Patent Office and some courts invalidated on double patenting grounds claims in divisional applications even though that application was filed in response to a division requirement.²

In Section 121, Congress provided that "a patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application."³

The Patent and Trademark Office interprets the "not be used as a reference" prohibition in Section 121 as providing protection against double patenting, provided the exact conditions are met.⁴ First, the divisional application must be filed in response to a

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¹ See Ch. 9 *supra*.

² See §§ 12.02[2][g], 12.02[4][g] *supra*.

³ 35 U.S.C. § 121.

⁴ U.S. Patent & Trademark Office, *Manual of Patent Examining Procedures* § 804.01 (3d ed. rev. 1976). See *Studiengesellschaft Köhle mbH v. Northern Petrochemical Co.*, 784 F.2d 351, 361, 228 USPQ 837, 844 (Fed. Cir. 1986), *cert. dismissed*, 478 U.S. 1028 (1986) (Newman, concurring: "Since the 1952 Patent Act, § 121 has protected patentees from the need to prove, before the PTO or the courts, that the claims of the divisional application are to an independent and distinct invention, when the patent examiner had determined during examination that the inventions were independent and distinct, and by requiring restriction had refused to examine the claims to any non-elected invention. The patent applicant thereafter had either to place the non-elected claims in a new patent application, or to abandon them. Section 121[3] effects a form of estoppel that shields the applicant from having to prove the correctness of the restriction requirement in order to preserve the validity of the second patent."); *Ex parte Camarata*, 151 USPQ 739 (Bd. App. 1966); *Ex parte Nantz*, 141 USPQ 523, 528 (Bd. App. 1963); *In re Joyce*, 115 USPQ 412 (Comm'r Pat. 1957) ("the prohibition . . . is clearly applicable in any instance in which the claim of the divisional application is for a species and is presented in that application after having been removed from a parent application in response to a requirement for restriction.").

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restriction requirement actually imposed and not withdrawn by the examiner. The prohibition does not apply if the applicant optionally files separate applications in a situation where restriction would have been required had the claims been joined in one application.⁵ It does not apply if the Office withdraws the restriction requirement—even after the applicant has filed the divisional application.⁶ On the other hand, the protection of Section 121 is not lost simply because the application to which the claims to a nonelected invention are transferred was filed prior to the imposition of the restriction requirement: “No practical distinction exists between an application filed for the first time as a result of a restriction requirement, and an application which is amended in full to comport with that requirement.”^{6.1}

Second, the claims in the second application or patent must be “consonant with the requirement made by the examiner,” that is, must not have been changed in material respects from the claims at the time the requirement was made.⁷ In *Lerner v. Ladd*, (1962)⁸ the applicant filed an original application disclosing and

⁵ *In re Ockert*, 245 F.2d 467, 468-69, 114 USPQ 330 (CCPA 1957); *In re Russell*, 239 F.2d 387, 112 USPQ 58 (CCPA 1956). See also *Studiengesellschaft Köhle mbH v. Northern Petrochemical Co.*, 784 F.2d 351, 360, 228 USPQ 837, 844 (Fed. Cir. 1986), *cert. dismissed*, 478 U.S. 1028 (1986) (Newman, concurring: “the safeguard of § 121[3] does not apply if the divisional application was voluntarily filed by the applicant and not in response to a PTO restriction requirement.”).

⁶ *In re Ziegler*, 443 F.2d 1211, 170 USPQ 129 (CCPA 1971). See also *Studiengesellschaft Köhle mbH v. Northern Petrochemical Co.*, 784 F.2d 351, 360, 228 USPQ 837, 844 (Fed. Cir. 1986), *cert. dismissed*, 478 U.S. 1028 (1986) (Newman, concurring: “Nor does [the safeguard of § 121[3]] apply if the restriction requirement was withdrawn by the examiner.”).

^{6.1} *Union Carbide Corp. v. Dow Chemical Co.*, 619 F. Supp. 1036, 1060, 229 USPQ 401, 417 (D. Del. 1985).

⁷ U.S. Patent & Trademark Office, *Manual of Patent Examining Procedure* § 804.01A(a) (3d ed. rev. 1976).

⁸ 216 F. Supp. 81, 84 136 USPQ 624, 626 (D.D.C. 1962).

See also *Ex parte MacAdams*, 206 USPQ 445 (P.T.O. Bd. App. 1978) (“[R]estriction was required in the instant case . . . but no restriction requirement has been made between claims drawn to the blend, per se, and the method of using it for the preparation of shaped articles therefrom by rotational molding as called for by the claims at issue. The indicated double patenting rejection, accordingly, is not seen to be precluded by 35 U.S.C.

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claiming both a combination pneumatic tacker and a certain cartridge that was an element of the combination. The examiner required division between the group of claims relating to the combination tacker and the group relating to the cartridge. The applicant elected to prosecute the first group in the original application, obtaining a patent therefore, and filed a divisional application containing the claims to the cartridge. Initially, the examiner rejected the claims to the cartridge as unpatentable over a patent on a cartridge in a stamp-affixing machine. The applicant amended his claim to state that the cartridge was in combination with a tacker, thus distinguishing the patent. The Board of Appeals reversed the examiner's rejection but entered as a new ground for rejection double patenting. The District Court affirmed. The amendment to the claims meant that the applicant was now claiming the same invention as embodied in the patent, not the "other invention" indicated by the Patent Office in requiring restriction.

Dicta in a number of decisions has questioned the scope of the "not be used as a reference" prohibition.* In *In re Ziegler*

121."); *Ex parte Nantz*, 141 USPQ 523, 529 (Bd. App. 1963) (applicant maintained line of division indicated by examiner).

Compare *Union Carbide Corp. v. Dow Chemical Co.*, 619 F. Supp. 1036, 1060, 229 USPQ 401, 418 (D. Del. 1985) ("It is almost inevitable that some refinement of the claims will occur after restriction is ordered, since restriction often comes as a preliminary step before the examiner reaches the merits of the patent claims. What is critical then, is that the distinction which prompted the PTO to require restriction because of the existence of more than one invention is retained in the divisional patent."); *Ex parte Edwards*, 231 USPQ 981, 983 (P.T.O. Bd. Pat. App. & Int'l 1986) ("The restriction requirement was between a polyol compound and the method of making it and the process of using that compound in admixture with an isocyanate to prepare a urethane foam. The file wrappers of the respective cases reflect that such line of division has been consistently maintained between two restricted inventions throughout the prosecution of the patents in issue . . . That some refinement of the claims has occurred is not important. Nor is it important that the claim at bar is drafted in product-by-process terms. What is critical is that the distinction which prompted the requirement because of the existence of more than one invention is retained in the patents in issue.").

One commentator argues that the divisional application need not fully comply with the examiner's restriction requirement. Killworth, "Unity of Invention in Patents: 35 U.S.C. 121," 54 J. Pat. Off. Soc'y 226, 242-43 (1972).

* *In re Zeigler*, 443 F.2d 1211, 170 USPQ 129 (CCPA 1971); *In re Russell*, 239 F.2d 387, 112 USPQ 38 (CCPA 1956) ("Moreover, since the section in

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